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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/481,153 | 01/12/2000 | Rodney H. Masters | P01506US2 | 5245 |

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FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

YIP, WINNIE S

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| ART UNIT | PAPER NUMBER |
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3637

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/481,153

Applicant(s)

MASTERS ET AL.

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,12-14 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part III DETAILED ACTION

This office action is in response to applicant's amendment filed on October 7, 2002.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The indicated allowability of claims 7-14 are withdrawn in view of further review and understood the claimed invention as regard to the reference as discussed follow.

Claim Objections

1. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Notice, "said grating sheet" is not consistent with the limitations recited in the body of the claim because of the "grating sheet" has not been positively claimed in the previous claim 7. The "grating sheet" has been only functionally recited in the preamble by a statement of "for ...". if applicant intends to claim a combination, all elements of the claimed invention must be positively recited. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim Rejections - 35 USC § 102

2. Claims 7-8, 12-14, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by documents C or E of AIMS of the information disclosure statement filed 07/07/2000.

AIMS teaches, Document C or E, a fastening system (see options I and II) comprising: a fiberglass grating sheet (AIMS 1 1/2" GRTG) being made of corrosion resistant material such as fiberglass and being capably secured to a structural member (the two U-shaped spacer members)

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of an offshore platform in an wave zone area (see description in Document A), a top plate (PL 5/8" RECESSED) being attached to the upper surfaced of the grating sheet, a bottom plate (L2 x ¼ x3-5" LG) being sized and shaped to be capably attached to the structural members of the offshore platform in a laterally extending direction for supporting the grating sheet thereon, a securing mechanism including a threaded member (stud) secured on the bottom plate and extending between the top and the bottom plates through an opening on the top plate such that by fastening a nut on a top surface of the top plate only from a position on a top surface of the grating sheet, the grating sheet is clamped together with and secured between the top and bottom plates.

In regard to claim 12, Option I of Document C, show the top plate having a cylindrical standoff (recessed) secured to the lower surface of the top plate for placement between adjacent grating bars of the grating sheet, the standoff having a bore and an opening sized and shaped to receive a nut and a portion of the threaded member extended therethrough from the bottom plate.

Claim Rejections - 35 USC § 103

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Document C or Document E in view of Document D of AIMS for the same reasons set for the office action mailed September 7, 2000.

Allowable Subject Matter

4. Claims 9-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations

of the base claim and any intervening claims for the same reasons set forth the prior office action mailed September 7, 2000.

Response to Arguments

5. Applicant's arguments filed October 7, 2002 have been fully considered but they are not deemed to be persuasive.

In response to applicant's argument that the bottom plate of Document C (or E) positioned underneath the grating sheet is not attached to the structural members, the U-shaped basic members, such that the stud of the securing mechanism is extended upwardly from the bottom plate to the upper plate, and the securing mechanism can not be secured only from a position on a top surface of the grating sheet as claimed invention, it is not deemed to be persuasive. In claims 7-8, 12-14, 18-20, applicant only claims an apparatus intended to be attached to the structural members for supporting the grating sheet to the structural member, but does not positively recite the grating sheet and the structural members and the bottom plate of the apparatus being secured to the structural members of a offshore platform. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the Document C (or E) teaches an apparatus comprising a bottom plate (LG) being attached to the bottom surfaces of two U-shaped basic members (PL 1), a threaded stud being secured to the upper surface of the bottom

plate, and the threaded stud extending upwardly from the bottom plate and passed through the opening of the upper plate and being secured on the top surface of the grating sheet.

Therefore, the lower plate (LG) of the apparatus of Document C (or E) is considered would be capably laterally secured to the structure support members by suitable connecting methods such as by welding before fastening the grating sheet thereon. Therefore, the threaded member of Document C (or E) can only be tightened by the nut on the top surface of the grating sheet as claimed as similar to applicant's embodiment shown in Fig. 8.

Therefore, the rejections are deemed proper.

Proposed Examiner's Amendment

6. The following claims are drafted by the examiner and considered to distinguish patentably over the art of record in this application, are presented to applicant for consideration:

In claim 7:

Lines 6-7, change "size and shaped for attaching" to "attached".

Line 10, change "the opening of the bottom plate" to "the bottom plate through the opening of the bottom plate".

Line 11, after "together", insert "with the grating sheet".

Line 14, change "atructural members" to – structural members--.

In claim 18:

Line 6, change "sized and shaped for attaching" to "being attached".

Line 8, after "sheet" insert "on the structural support members".

Line 10, after "together" insert "with the grating sheet". And after "top surface of" insert "the grating sheet of".

Supplemental Reissue Oath/Declaration Requirement

7. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

Original Patent

8. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Amendment To Reissue Application

9. Notice, in a reissue application, all amendments must be made with respect to the claims in the patent, not to the last amended version of the claims of the prior amendments as common in non-provisional practice. Therefore, any subsequent amendments, to a claim must also show the insertions or deletions of the prior amendments as though they had not been previously made as referring to the patent. For example, claim 20, the deletion to [said] should be canceled from the claim without a bracket, and the whole claim should be underlined since it is a new claim to the original patent. In claim 18, line 14, a deletion to [able] should be canceled

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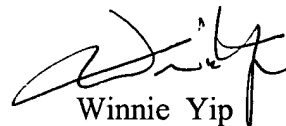
without a bracket from the claim, and the whole claim should be underlined since it is a new claim to the original patent.

Inquiry Contacts

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Winnie Yip
Patent Examiner
Art Unit 3637

wsy
December 18, 2002